

**UNITED STATES DISTRICT COURT**  
**SOUTHERN DISTRICT OF CALIFORNIA**

THE LARYNGEAL MASK COMPANY  
LTD. and LMA NORTH AMERICA, INC.,

Plaintiffs,

vs.

AMBU A/S, AMBU, INC., AMBU LTD.,  
and AMBU SDN, BHD.

Defendants.

\_\_\_\_\_  
AND RELATED COUNTERCLAIM.

CASE NO. 07cv1988 DMS(NLS)

**ORDER CLARIFYING ORDER  
GRANTING MOTION TO  
DISQUALIFY COUNSEL**

**[Docket No. 45]**

This matter comes before the Court on Defendants' motion for clarification of this Court's February 25, 2008 Order disqualifying Finnegan Henderson Farabow Garrett & Dunner, LLP ("Finnegan") from acting as defense counsel in this case ("Disqualification Order"). Plaintiffs have filed an opposition to the motion, and Defendants have filed a reply. In light of this motion, the Court clarifies the Disqualification Order as indicated below.

**I.**

**BACKGROUND**

On October 15, 2007, Plaintiffs The Laryngeal Mask Company LTD and LMA North America, Inc. filed the present Complaint against Defendants Ambu A/S, Ambu Inc., Ambu Ltd. and Ambu Sdn. Bhd. The Complaint alleges infringement of United States Patents Number 5,303,697 ("the '697

1 Patent”) and 7,156,100 (“the ‘100 Patent”). Plaintiffs filed a First Amended Complaint on October  
2 17, 2007, to which Defendants filed an Answer and Counterclaim on December 5, 2007. Plaintiffs  
3 filed their Answer to the Counterclaim on December 20, 2007.

4 The following day, Plaintiffs filed a motion to disqualify Finnegan from acting as defense  
5 counsel in this case. The basis for that motion was Plaintiffs’ meeting with Finnegan to discuss its  
6 possible representation of Plaintiffs in this case. The motion was fully briefed, and on February 25,  
7 2008, the Court granted the motion. In the Disqualification Order, the Court stated: “Finnegan  
8 Henderson Farabow Garrett & Dunner, LLP shall not represent or assist Defendants with this lawsuit  
9 and shall not consult or share work product with new counsel.” (Disqualification Order at 13.)

10 Defendants and their new counsel at Fenwick & West LLP (“Fenwick”) seek clarification of  
11 this particular statement in the Disqualification Order. Specifically, Defendants want to know whether  
12 Fenwick may have copies of (1) all documents Defendants provided to Finnegan, and (2) all third  
13 party documents in Finnegan’s possession related to prior art.

## 14 II.

### 15 DISCUSSION

16 Defendants argue the Disqualification Order should be clarified to allow them to obtain the  
17 requested documents for three reasons. First, they assert they will incur needless expense in  
18 recollecting and recopying the documents they provided to Finnegan. Second, Defendants contend  
19 that Fenwick will be unable to fully comply with its discovery obligations if these documents are not  
20 turned over. Finally, Defendants argue they should not be penalized for Finnegan’s conduct.  
21 Plaintiffs argue the Disqualification Order is clear, and it prohibits the disclosure of the requested  
22 documents.

23 In general, the Court agrees with Plaintiffs that the language of the Disqualification Order  
24 prohibits disclosure of the requested documents. Providing the requested documents would involve  
25 Fenwick “consulting” with Finnegan, and Finnegan providing “assistance” with the lawsuit, both of  
26 which are prohibited by the Disqualification Order. On this basis alone, Fenwick is not entitled to the  
27 requested documents.  
28

1 Defendants' justifications for the documents are also unconvincing. As to the first category,  
2 it would seem those documents could just as easily be obtained from Defendants as they could from  
3 Finnegan. Presumably, Defendants kept a record of what documents were sent, and thus the time  
4 required to recollect and recopy those documents should be minimal. Defendants' records should also  
5 alleviate Fenwick's concern that it receives the same documents that Defendants provided to  
6 Finnegan. To the extent Defendants' records do not do so, Fenwick will admittedly "be requesting  
7 documents and other information" from its clients to comply with its discovery obligations.

8 Turning to the second category of documents, which consist of prior art references, those  
9 documents should be available to the public. Thus, Fenwick may access those documents without  
10 resorting to Finnegan's files and records.<sup>1</sup> Defendants argue it will be expensive for Fenwick to repeat  
11 the prior art searches, but that cost does not outweigh the risk that Plaintiffs' confidential information  
12 could be disclosed to Defendants.

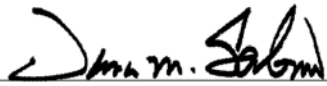
### 13 III.

### 14 CONCLUSION

15 For these reasons, the Court finds its Disqualification Order prohibits Fenwick from obtaining  
16 the requested documents from Finnegan.

17 **IT IS SO ORDERED.**

18 DATED: May 15, 2008

19   
20 \_\_\_\_\_  
21 HON. DANA M. SABRAW  
22 United States District Judge  
23  
24  
25

26 \_\_\_\_\_  
27 <sup>1</sup> The parties devote considerable attention to the issue of whether these documents are  
28 protected by the work product doctrine, and thus, whether Finnegan may "share" the documents with  
Fenwick. The Court finds it unnecessary to delve into this issue since providing the documents would  
constitute "assistance" and require "consultation" from Finnegan, both of which are precluded by the  
Disqualification Order.